

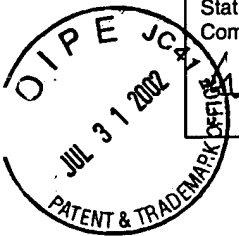
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7/26/02
Date



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

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IN RE APPLICATION OF

Art Unit: 1613

O'SULLIVAN ET AL.

Examiner: R. Gerstl

APPLICATION NO: 09/091,333

FILED: OCTOBER 26, 1998

FOR: PROCESS FOR THE PREPARATION OF 2-CHLORO-5-
CHLOROMETHYL-THIAZOLE

#29
R. Harman
10/3

Assistant Commissioner for Patents
Washington, D.C. 20231

APPEAL BRIEF

Sir:

This is an ex parte appeal under 35 USC § 134 from the final rejection of December 21, 2001 issued by the primary Examiner, finally rejecting claims 1 – 7, 9, 10, 12, 13 and 69.

The Notice of Appeal was mailed to the Patent and Trademark Office by first class mail with a certificate of mailing on, date stamped as received on March 26, 2002 making the brief due on May 26, 2002. The appeal fee was paid in a previous appeal herein. A Petition for Extension of time for two-months and the requisite fee therefor are attached hereto, thereby extending the period for filing this Brief until July 26, 2002.

(1) REAL PARTY IN INTEREST

By Assignment dated June 12, 1998, the present application was assigned to Novartis Crop Protection, Inc. (now Syngenta Crop Protection, Inc.), which is an affiliate of Syngenta Corporation, which is a wholly owned subsidiary of Syngenta AG, Basle Switzerland.

(2) RELATED APPEALS AND INTERFERENCES

To the best of Appellant's, Appellant's legal representative, and Appellant's assignee's knowledge there are no other appeals or interferences which will directly affect or be directly affected or have a bearing on the Board's decision on the pending appeal.

(3) STATUS OF THE CLAIMS

Claims 1-68 were originally filed.

Claims 8, 11, 14, 17, 21, 25, 28, 32, 36, 39, 43, 47, 53, 57, 65 and 68 were canceled by amendment dated June 16, 1998.

Claims 15, 16, 18-20, 22-24, 26, 27, 29-31, 33-35, 37, 38, 40-42, 44-46, 48-52, 54-56, 58-64, 66 and 67 stand withdrawn pursuant to Rule 142(b).

Claim 69 was added by amendment dated November 19, 2001.

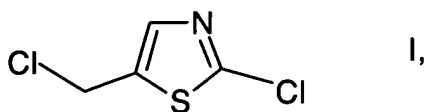
The claims on appeal, 1 – 7, 9, 10, 12, 13 and 69, stand finally rejected under 35 USC § 102(g). A clear copy of the appealed claims appears in the Appendix.

(4) STATUS OF AMENDMENTS

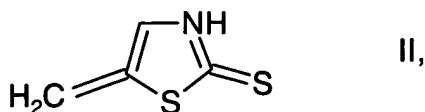
The claims were not amended in response to the final rejection. A Notice of Appeal was the sole response. An Amendment under 37 CFR 1.116 is presented herewith to cancel the non-elected claims 15, 16, 18-20, 22-24, 26, 27, 29-31, 33-35, 37, 38, 40-42, 44-46, 48-52, 54-56, 58-64, 66 and 67.

(5) SUMMARY OF THE INVENTION

The invention relates, *inter alia*, to a process for preparing a compound of the formula



which comprises reacting a compound of the formula



in free form or in salt form, with a chlorinating agent.

The present invention also pertains to several alternative processes for preparing a compound of formula I.

(6) ISSUES ON APPEAL

The final rejection raises two issues.

1. ARE CLAIMS 1 – 7, 9, 10, 12, 13 and 69 UNPATENTABLE UNDER 35 USC §102(g) BASED UPON CLAIM 1 OF U.S. PATENT NO. 5,679,796?
2. IS CLAIM 1 UNPATENTABLE UNDER 35 USC § 112, SECOND PARAGRAPH, AS BEING DIRECTED TO AN IMPROPER MISJOINDER OF INVENTIONS?

(7) GROUPING OF CLAIMS

The claims do not stand or fall together. Each of the claims present different issues with respect to whether a proper case has been made out by the Examiner regarding their coverage of the “same or substantially the same subject matter” as the claim of the ‘796 patent. Accordingly, each claim should be considered separately.

(8) ARGUMENT

The Examiner finally rejected claims 1 – 7, 9, 10, 12, 13 and 69 under 35 U.S.C. § 102(g) (presumably § 102 (g) (2)) based on claim 1 of U.S. patent no. 5,679,796 (“the ‘796 patent”) and cites In re Oguie, 186 USPQ 227 (CCPA 1975) in support thereof.

Appellants base this appeal upon error that is apparent in the Examiner's erroneous application of § 102(g) of the patent statute. As no proper prima facie case under § 102(g) has been made out by the Examiner, the rejection fails and the Examiner should be reversed.

Section 102 (g) of the patent statute provides:

- (1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or
- (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

More specifically, the present application 09/091,333 is a § 371 of international application no. PCT/EP96/05564 filed December 12, 1996 having a § 119(a) priority date of **December 21, 1995** based on Swiss application no. 3636/95. The § 371 requirements of the above-identified application were met on October 26, 1998.

The cited U.S. patent 5,679,796 was granted on **October 21, 1997** based on an application filed on December 13, 1996 and facially indicates a foreign priority of December 22, 1995. Accordingly, the '796 patent is not available as a reference against the instant claims.

With respect to the § 102(g) rejection over claim 1 of the '796 patent, Appellants have neither contested nor lost priority with respect to the subject matter of instant claim 1. Nor do Appellants concede priority with respect to the subject matter of claim 1. To the contrary, Appellants have requested that an interference be declared between the present application and the '796 patent in the Amendment mailed November 19, 2001. Accordingly, no grounds exist for rejecting claim 1 under § 102(g) in the manner suggested by the Examiner.

Likewise, Appellants have not contested, lost or conceded priority with respect to the subject matter of claims 2 – 7, 9, 10, 12, 13 or 69. Accordingly, no grounds exist for rejecting these claims under § 102(g) in the manner suggested by the Examiner.

The Examiner cites In re Oguie, *supra*, as supporting the present rejection. However, Oguie is distinguished from the present case. In Oguie, the appellant refused to enter into an interference by failing to copy a claim suggested by the examiner, thereby depriving the patentee (Iwata) of an opportunity to prove priority. In the present case, the Examiner refuses to allow Appellants to enter into an interference by failing to accept the originally presented claim 2 in lieu of a duplicate claim (MPEP § 706.03; 37 CFR 1.75) requested by the Examiner, thereby depriving Appellants of an opportunity to prove priority.

MPEP § 2306.01 provides guidance with respect to the situation where, as here, a patent has a filing date later than an application (See, e.g., pp. 2300-10 to 2300-11):

Although a patent which has an effective U.S. filing date later than the effective filing date of an application is not prior art against that application, the application should not be issued if the application and patent contain claims to the same patentable invention. In order to avoid the issuance of two patents to the same patentable invention, the examiner should take steps to propose an interference between the application and the patent.

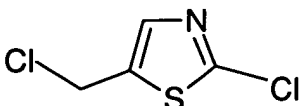
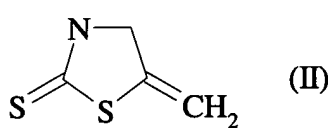
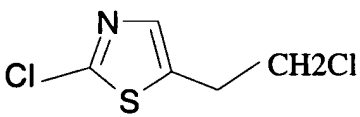
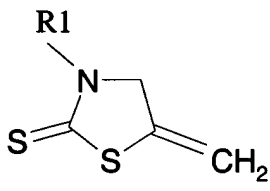
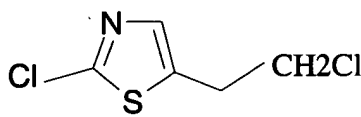
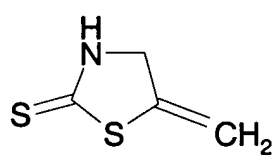
If the application contains at least one allowable claim drawn to the same patentable invention as at least one patent claim, the examiner may propose the interference by proceeding as described in MPEP § 2309.

If the application discloses, but does not claim, an invention claimed in the patent, the examiner should suggest a claim or claims to the applicant (see MPEP § 2305) ... (emphasis supplied).

In the present case, original claim 2 was indicated as being allowed in the Official Action, paper no. 18, mailed September 22, 2000. Accordingly, as of September 22, 2000, the application contained at least one allowable claim drawn to the same patentable invention as the claim of the '796 patent. Therefore, the Examiner should have set up an interference at that time, but instead proposed a claim that was a substantial duplicate (MPEP § 706.03; 37 CFR 1.75) of allowed claim 2.

The table below compares Claim 2, as originally filed, to Claim 1 of the patent and the suggested claim for copying.

Comparison Table

<u>Appellants Original Claim 2</u>	<u>Claim 1 of 5,679,796</u>	<u>Suggested Claim for Copying</u>
<p>A process for preparing a compound of the formula</p>  <p style="text-align: right;">I,</p> <p>which comprises reacting a compound of the formula</p>  <p style="text-align: right;">(II)</p> <p>in free form or in salt form, with a chlorinating agent.</p>	<p>Process for the preparation of 2-chloro-5-chloromethylthiazole of the formula (I)</p>  <p style="text-align: right;">(I)</p> <p>characterized in that 5-methylene-1,3-thiazolidine-2-thione of the formula (II)</p>  <p style="text-align: right;">(II)</p> <p>in which R1 represents hydrogen or the group R2-CO-, in which R2 represents alkyl or optionally substituted phenyl, are reacted with a chlorinating agent, optionally in the presence of a diluent.</p>	<p>Process for the preparation of 2-chloro-5-chloromethylthiazole of the formula (I)</p>  <p style="text-align: right;">(I)</p> <p>characterized in that 5-methylene-1,3-thiazolidine-2-thione of the formula (II)</p>  <p style="text-align: right;">II,</p> <p>is reacted with a chlorinating agent, optionally in the presence of a diluent.</p>

It is clear from the above comparison that Appellants' original claim 2 is directed to "substantially the same invention" as the issued patent, U.S. 5,679,796. This has been pointed out to the Examiner in several communications.

37 CFR 1.605 (a) states:

If no claim in an application is drawn to the same patentable invention claimed in another application or patent, the examiner **may** suggest that an applicant present a claim drawn to an invention claimed in another application or patent for the purpose of an interference with another application or a patent.

In the present case, Appellants submit that 37 C.F.R. 1.605(a) does not apply since there is a claim already present in the application drawn to the same patentable invention. Further, it was not required that the Examiner present a claim in the case where there is a claim present in the application drawn to substantially the same patentable invention. In order for an application claim to be for "substantially the same subject matter" as a patent claim, it must contain all the material limitations of the patent claim. Rieser v. Williams, 255 F.2d 419, 118 USPQ 96 (CCPA 1958). Again, from the above chart, it is clear that all of the material limitations of the patent claim are present in original claim 2.

Appellants concede that the claim suggested by the Examiner, claim 69, was not added until the amendment dated November 19, 2001. However, Appellants assert that this fact should not result in any disclaimer since the application contains an allowed claim 2 (originally filed) that is duplicative and directed to substantially the same patentable invention as the suggested claim.

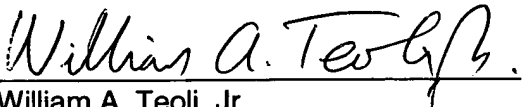
Accordingly, for the reasons above, Appellants respectfully submit that the § 102 (g) rejection of claims 1 – 7, 9, 10, 12, 13 and 69 is in error as to fact and law and should be reversed.

Appellants respectfully traverse the § 112, second paragraph, rejection of claim 1. Appellants respectfully submit that one of ordinary skill in this art, having the instant disclosure and claims before him, would be reasonably certain as to the exact subject matter encompassed by claim 1. Moreover, the Examiner's misjoinder argument does not obtain, as it clearly is appropriate to include interrelated process subject matter in a single claim. This interrelationship rather than the classification in separate classes should be the overriding factor in determining the propriety of the claim. Accordingly, Appellants submit that the § 112, second paragraph, rejection of claim 1 should be reversed.

If any fee under 37 CFR § 1.17 is due in connection with this Appeal Brief, the Assistant Commissioner is authorized to charge Deposit Account No. 50-1676 in the name of Syngenta Crop Protection, Inc. for the appropriate amount.

Respectfully submitted,

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Reg. No. 33,104

Date: July 26, 2002

ENCL. Appendix